

**REMARKS**

Reconsideration and allowance of the subject application are respectfully requested. Claims 4-10 are now pending. In this Reply, Applicants have canceled claims 1-3 without prejudice or disclaimer, and have rewritten claims 4 and 8 in independent form.

**Prior Art Rejections**

1. § 102 Rejection: Desai

Claims 1, 4, and 7 stand rejected under 35 U.S.C. § 102 as allegedly being anticipated by Desai et al. (U.S. Patent 5,862,509). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

As noted above, independent claim 1 has been canceled without prejudice or disclaimer and the contents thereof have been incorporated into claim 4, which is now an independent claim. As amended, independent claim 4 is directed to a navigation device comprising: a storage means for storing map data containing road time restriction information; a route searching means for searching a route to a destination referring to the map data stored in the storage means; and a display means for displaying the route searched by the route searching means, wherein when a road with time restriction is present in an optimal route to the destination, the route searching means outputs the optimal route to the display means, and at the same time searches a route by-passing the road

with time restrictions and outputs the route by-passing the road with time restrictions to the display means.

In accordance with the present invention, consideration of roads with "time restrictions" is not limited to identifying/considering those roads with restrictions that directly relate to whether the vehicle is restricted from access to a given road. For example, a road with a time restriction may include a restriction (such as a time-based access restriction) that does not prevent the vehicle from legally passing on the road, but which nonetheless may affect traffic congestion. Therefore, a road with a time restriction identified in the optimal route may not affect the vehicle legally, but nonetheless is identified so that the user can consider the impact of such a time restriction on traffic congestion, etc. In this context, claim 4 specifies that the route searching means outputs the optimal route to the display means, regardless of whether the optimal route includes a road with a time restriction, and at the same time searches for a route by-passing a road with time restrictions in the optimal route and outputs the route by-passing the road with time restrictions to a display means. In this way, the user is able to choose between the optimal route containing a road with a time restriction, e.g., based on the user's experience with the effect of such a time restriction on

traffic congestion, or a route that by-passes the road with time restrictions.

*Desai* discloses a vehicle navigation system that generates a navigation route to a destination by considering "time to vehicle restrictions" (TVRs). The navigation system of *Desai* generates a route between an origin and a destination by referring to map data and time-restriction information. (See e.g., col. 3, ll. 56-65; col. 6, ll. 42-44). An embodiment disclosed by *Desai* may generate a visual display of the optimum route between the origin and destination (see e.g., step 147 in Fig. 8B). As seen for example in the flow diagram of Fig. 8B, when a calculated route between the origin and destination includes a time restriction that applies to the vehicle, based on location and time of day, the navigation system disclosed therein computes a new route between the origin and destination, and it is this route that is displayed. Therefore, it is evident that consideration of roads with time restrictions in *Desai* is limited to time restrictions that directly relate to the vehicle. Consequently, there is no teaching in *Desai* of outputting an optimal route to the display means and, when a road with a time restriction is present in the optimal route, also searching for and outputting to the display means a route that by-passes the road with time restrictions as required by independent claim 4.

According to MPEP §2131, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claims." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989). The elements must be arranged as required by the claims, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 ( Fed. Cir. 1990).

Applicants respectfully submit that the Office Action has failed to establish the required *prima facie* case of anticipation because the cited reference, *Desai*, fails to teach or suggest each and every feature as set forth in the claimed invention.

At least in view of the above, Applicants respectfully submit that *Desai* fails to anticipate claim 4, or claims depending therefrom, and respectfully request that the rejection be withdrawn.

2. § 103 Rejection: Desai in View of Nomura

Claims 2-3, 5-6, and 8 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over *Desai* in view of *Nomura* (U.S. Patent 5,371,678).

Initially, Applicants note that dependent claims 2-3 have been canceled herein. Regarding dependent claims 5 and 6 (depending from claim 4), although the Examiner relies on the secondary reference, *Nomura*, as allegedly teaching incremental features of these claims, Applicants respectfully submit that the Examiner's reliance on *Nomura* fails to make up for the fundamental deficiency of *Desai* discussed above with respect to claim 4.

Accordingly, Applicants respectfully submit that the asserted combination of *Desai* in view of *Nomura* (assuming these references may be combined, which Applicants do not admit) fails to establish *prima facie* obviousness of claims 5-6.

Regarding claim 8, as discussed above, *Desai* calculates a route for display from which relevant time restricted roads have been removed. Accordingly, Applicants respectfully submit that modifying *Desai* to display details of a time restriction would not have been obvious in the context of the system disclosed therein. Furthermore, Applicants fail to see how such a feature is disclosed in the secondary reference.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the Examiner's rejection under 35 U.S.C. § 103 based on the asserted combination of *Desai* and *Nomura*.

3. § 103 Rejection: *Desai* - *Nomura* - *Mutsuga*

Claims 9-10 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over *Desai* in view of *Nomura* and *Mutsuga et al.* (U.S. Patent 5,911,773). This rejection is respectfully traversed.

As set forth on page 5 of the Office Action, the Examiner relies on *Mutsuga* as allegedly teaching incremental features of dependent claims 9 and 10. Applicants submit, however, that the Examiner's reliance on this additional secondary reference fails to make up for the deficiencies of the asserted combination of *Desai* and *Nomura* discussed above with respect to independent claim 8. Accordingly, the asserted combination of *Desai*, *Nomura*, and *Mutsuga* (assuming these references may be combined, which Applicants do not admit) fails to establish *prima facie* obviousness of the rejected claims.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the Examiner's rejection under 35 U.S.C. § 103 based on the asserted combination of *Desai*, *Nomura*, and *Mutsuga*.

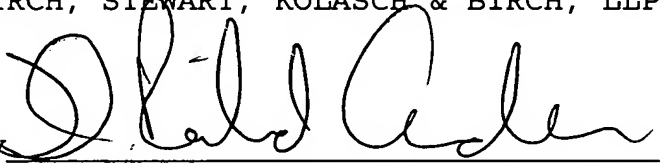
Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

  
By \_\_\_\_\_

D. Richard Anderson, #40,439

DRA/jdm  
1163-0386P

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000